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Serial Number: 08/608,744

APPLICATION NUMBER	FILED DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
08/608,744	02/29/96	NAKAMURA	YAO-3350

25M1/1015

PAUL PRESTIA RATNER & PRESTIA 500 N GULPH RD PO BOX 980 VALLEY FORGE PA 19482	DATE MAILED: 10/15/97
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illumination device, classified in Class 362, subclass 317  
This is a communication from the examiner in charge of your application.  
COMMISSIONER OF PATENTS AND TRADEMARKS

classified in Class 250; OFFICE ACTION SUMMARY

☒ Responsive to communication(s) filed on 2-29-96 (new application)

- ☐ This action is FINAL.
- ☐ Since this application is in condition for allowance, except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

the following reasons:  
A shortened statutory period for response to this action is set to expire 30 days month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Subcombination. Inventions in this relationship are distinct if

- Disposition of Claims  
it can be shown that (1) the combination as claimed does not
- ☒ Claim(s) 1-153 is/are pending in the application.  
Of the above, claim(s) 1-153 is/are withdrawn from consideration.
- ☐ Claim(s) 1-153 is/are allowed.
- ☐ Claim(s) 1-153 is/are rejected.
- ☐ Claim(s) 1-153 is/are objected to.
- ☒ Claim(s) 1-153 are subject to restriction or election requirement.

instant case, the combination as claimed does not require the

Application Papers  
particulars of the subcombination as claimed because any

- ☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on device is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on device is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner subcombination has separate utility.
- ☐ The oath or declaration is objected to by the Examiner.

device in a document scanner not

Priority under 35 U.S.C. § 119  
for a contact image sensor.

- ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☒ All ☐ Some ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received:

- ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- ☐ Notice of Reference Cited, PTO-892
- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s) \_\_\_\_\_
- ☐ Interview Summary, PTO-413
- ☒ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

-SEE OFFICE ACTION ON THE FOLLOWING PAGES-

Applicant's IDS's filed on 5-24-96, 11-12-96, and 5-30-97 have been received.

Restriction to one of the following inventions is required under 35 U.S.C. § 121:

I. Claims 1-73, 95-96, and 100-107, drawn to an illumination device, classified in Class 362, subclass 317.

II. Claims 74-94, drawn to a contact image sensor, classified in Class 250, subclass 208.1.

III. Claims 97-99, and 108-153, drawn to a document illumination device, classified in Class 358, subclass 484.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations. (M.P.E.P. § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because any illumination device can be used in a contact image sensor with various photosensors. The subcombination has separate utility such as an illumination device in a document scanner not comprising a contact image sensor.

Inventions I and III are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations. (M.P.E.P. § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because any illumination device can be used to illuminate a document in a document scanner. The subcombination has separate utility such as an illumination device for an image sensor for scanning objects other than a document.

Inventions II and III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention III has separate utility such as a document scanner employing a sensor other than a contact image sensor. See M.P.E.P. § 806.05(d).

Because these inventions are distinct for the reasons given above, and the search for any one group is not required for the other groups, restriction for examination purposes as indicated is proper.

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Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed.

A telephone call was made to Steven E. Koffs on 9-26-97 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. § 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 C.F.R. § 1.48(b) and by the fee required under 37 C.F.R. § 1.17(h).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John R. Lee whose telephone number is (703) 308-4116. The examiner can normally be reached on Mon-Fri from 8:00 to 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ed Westin, can be reached on (703) 308-4823. The fax phone number for this Group is (703) 308-7726.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0956.

*Edward Westin*

EDWARD P. WESTIN  
SUPERVISORY PATENT EXAMINER  
GROUP 250

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Lee/ab

September 30, 1997